

Rejections Under 35 U.S.C. § 103

Claims 1 (independent), 3, and 9 are rejected under 35 U.S.C. § 103(a) as obvious based on Krishna, U.S. 6,515,240, in view of Hiwatahi, U.S. 4,146,758. According to the Office Action, Krishna shows a rotary light switch with a plurality of spring-loaded axial positions in which “a first axial position with a corresponding first lighting function is activated by a pulling movement from a neutral (“off”) position[,]” but not “an axial position with a corresponding lighting function activated by a pushing movement.” However, according to the Office Action, Hiwatahi discloses a rotary light switch with a plurality of spring-loaded axial positions in which “a first axial position with a corresponding first function is activated by a pushing movement[.]” Therefore, according to the Office Action, it would have been obvious to modify the Krishna switch “by adding an additional function activated by a pushing movement from the neutral position [as per Hiwatahi], in order to increase the functionality [of the switch] without requiring an additional switch or having to make the switch significantly larger in size.” Applicant traverses this rejection and requests that it be withdrawn.

First, although the Office Action does not so state, Applicant believes the Examiner meant to assert more fully that Hiwatahi shows a rotary switch with a first function that is activated by a pushing movement from a neutral position. Assuming that to be the case, Applicant submits that the Examiner is mistaken as to what Hiwatahi discloses. Hiwatahi discloses a rotary switch that has two axial positions, with a multiplicity of functional angular positions – in particular, to select channels on a CB radio – at each of those axial positions. This configuration allows one range of channels to be selected by turning the knob when the switch is in one axial position and another range of channels to be selected by turning the knob when the switch is in the second axial position. (See, for example, column 2, lines 33-36 of Hiwatahi.) As such, the Hiwatahi switch does not have a neutral position and a first position with respect to that neutral position; rather, the Hiwatahi switch has two equally functional axial positions. Furthermore, Applicant notes that with the Hiwatahi switch, pushing the switch in (or pulling the switch out) does not activate a function; rather, it is turning the switch from one rotary position to another that activates the various functions (to the extent tuning a CB to different channels could be construed as activating a function), with pushing and pulling the switch simply determining

which of those various functions (channels) can be activated. Accordingly, the proffered combination does not yield the claimed invention.

Furthermore, still assuming the full statement of what Hiwatahi discloses was intended to be as set forth above, Applicant submits that the proffered combination would not have been made but for impermissible hindsight. In particular, while Applicant acknowledges that an Examiner must, of necessity, rely on hindsight to conduct his or her search for relevant references, once those references have been located, there must be reason why, independent of what an applicant has disclosed and KSR notwithstanding, one having skill in the art would have made the proffered modification and/or combination of references. Here, “boiled down” to its bare essence, the Examiner’s position seems to be that Krishna shows out/neutral and Hiwatahi shows neutral/in, so “stapling together” the switches by means of “common” neutral positions yields out/neutral/in. Applicant submits, however, that given just these two references (i.e., without Applicant’s own teaching to guide the analysis), one having skill in the art could have been motivated just as easily – if not actually more likely – simply to swap the relative push/pull arrangement of one switch in light of the other, e.g., to make Krishna’s switch in/neutral as per the apparent interpretation of Hiwatahi’s switch or, conversely, to make Hiwatahi’s switch neutral/out as per Krishna’s switch. The two switches are, after all, both two-axial-position switches, and such an alternate modification would be far more consistent with the clear teaching of the two references. Given the ease and plausibility of such an alternate combination of the two references, Applicant submits that the hindsight-based nature of the Examiner’s far more strained combination of the references is put into stark relief.

Moreover in this regard, Applicant notes that in *KSR*, the claimed invention combined wholesale components that were known in the art, and the components as so combined did not function differently than they did when separate. Here, in contrast, the Examiner is apparently making a combination that explicitly changes the function of at least one switch – possibly even both switches – from that of a two-position switch to a three-position switch. As such, the combination is improper and can not stand. (See, for example, the PTO’s Examination Guidelines for Determining Obviousness in view of *KSR* released October 10, 2007, at 72 Fed. Reg. 57526, 57529 (emphasis added) (“[t]he rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one

skilled in the art could have combined the elements as claimed by known methods with no changes in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the arts at the time of the invention.”.)

Alternatively, if Applicant is incorrect as to the seemingly intended basis for the rejection and the Examiner really did mean only to rely on the fact that the Hiwatahi switch can be pushed in (without regard to what the switch is being pushed in relative to), then Applicant submits that the rejection becomes even more clearly predicated on impermissible hindsight, as such a statement strips the reference of all other features the reference discloses and focuses only on that feature which the Examiner wants to see. In this regard, Applicant notes that *KSR* refers repeatedly to predictability. Given all other features present in the secondary reference, Applicant queries why it would have been predictable for one of skill in the art to have focused solely on the one particular feature the Examiner has focused on if not for impermissible hindsight?

In view of this analysis, Applicant traverses the rejection and requests that it be withdrawn.

Claim 2 is rejected under 35 U.S.C. § 103(a) based on Krishna in view of Hiwatahi as applied to claim 1 and further in view of Schultz, U.S. 3,500,120, on which the Examiner relies for disclosure of a switch in which the positions correspond to the specific claim-recited functions. Similarly, claim 10 is rejected under 35 U.S.C. § 103(a) based on Krishna in view of Hiwatahi as applied to claim 1 and further in view of Williams, U.S. 4,900,946, on which the Examiner relies for disclosure of a switch in which the positions correspond to other specific claim-recited functions. Applicant traverses these rejections for at least the reasons set forth above and requests that they be withdrawn.

Allowable Subject Matter

Claims 11-21 are allowed. In view of the foregoing, however, Applicant submits that all pending claims are in condition for allowance, and timely Notice to that effect is respectfully requested.

The undersigned representative requests any extension of time that may be deemed necessary to further the prosecution of this application.

The undersigned representative authorizes the Commissioner to charge any additional fees under 37 C.F.R. 1.16 or 1.17 that may be required, or credit any overpayment, to Deposit Account No. 14-1437, referencing Attorney Docket No.: 7589.159.PCUS00.

In order to facilitate the resolution of any issues or questions presented by this paper, the Examiner may directly contact the undersigned by phone to further the discussion.

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Respectfully submitted,



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